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Paper No. 11

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OFFICE OF PETITIONS

In re Application of :
Douglas Boehner :
Application No. 09/781,530 : ON PETITION
Filed: February 8, 2001 :
Attorney Docket No. SPORT-001 :

This is a decision on the petition under 37 CFR 1.137(a), filed on June 2, 2005, to revive the above-identified application.

The application became abandoned on September 2, 2002, for failure to file a proper response to the Notice of Non-Responsive Amendment mailed on August 1, 2002, which set a one-month period for reply. A Notice of Abandonment was mailed on November 18, 2002.

In the petition, applicant asserted that his former attorney, Charles Hartman, failed to respond within the period allowed, and subsequently did not communicate the problem to applicant. Applicant stated the Examiner attempted to contact Mr. Hartman by telephone, as indicated in the Notice of Abandonment; however, his phone was disconnected. Applicant further stated that it was unclear if Mr. Hartman ever received the Notice of Non-Responsive Amendment or the Notice of Abandonment. Applicant asserted that he attempted to contact Mr. Hartman to inquire about the status of the subject application, but was unable to locate him. Thereafter, applicant instructed Attorney John W. Crosby to file the present petition to revive.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in

> compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.
>
> (2) The petition fee as set forth in 37 CFR 1.17(l);
>
> (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. The Director may require additional information where there is a question whether the delay was unintentional; and
>
> (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

This petition lacks item (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".[1] Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[2]

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).[3] Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding

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[1] 35 U.S.C. § 133.

[2] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

[3] See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[4]

First, applicant averred that the delay was unavoidable because Mr. Hartman failed to properly and diligently respond to the Notice of Non-Responsive Amendment and the Notice of Abandonment, as well as communicate such information to applicant. The United States Patent and Trademark Office (USPTO) must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those action or inactions.[5] Specifically, applicant's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay with the meaning of 35 U.S.C. § 133 or 37 CFR 1.137(a).[6]

An adequate showing of unavoidable delay must include a showing from Mr. Hartman as to why he did not take action to prevent the application from becoming abandoned while he was prosecuting the application. Applicant should send a letter (accompanied by a copy of this decision) to Mr. Hartman by registered or certified mail, return receipt requested, indicating that the USPTO is requesting his assistance in determining the circumstances surrounding the abandonment of this application, and is specifically requesting that Mr. Hartman provide a statement within a specified period (*e.g.*, one month) as to (1) whether the Notice of August 1, 2002, was docket for reply; (2) why the reply was not timely filed; (3) what actions were taken to prevent this application from becoming abandoned; and (4) what action(s) were taken upon receipt of the Notice of Abandonment. In the event that Mr. Hartman does not provide a statement within the specified period, applicant should submit a copy of such letter and the return receipt with any renewed petition.

Second, applicant asserted that he was unable to locate Mr. Hartman to inquire into the status of the application. However, applicant did not provide any statement or documentary showing in support of his assertion that Mr. Hartman did not communicate with him or that he was unable to locate Mr. Hartman during the aforementioned period. Specifically, applicant must show (1) the dates and the number of times he attempted to contact Mr. Hartman; (2) his efforts to locate Mr. Hartman; and (3) when and under what circumstances applicant first became aware that the application was abandoned. Additionally, the documentary showing should include letters, contemporaneous notes by applicant, or the like. If Mr. Hartman billed applicant for services rendered for prosecuting the application during this time period, applicant should supply them to the Office, as well as copies of payments rendered by applicant to Mr. Hartman. **The Office requests that applicant redact any personal identifying information such as bank account numbers, credit card information, social security number, etc. from any documents before submitting them to the USPTO, as this information may become open to the public.**

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[4] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

[5] Link v. Wabash, 370 U.S. 626, 633-634 (1962).

[6] Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978).

The Office notes that approximately 31 months lapsed from the mailing date of the Notice of Abandonment and the filing of the present petition. Applicant is reminded that any omissions by Mr. Hartman did not relieve applicant from his obligation to exercise diligence in furthering the prosecution of this application.[7] "Diligent inquiry into the status of the application is required."[8] Applicant may not have known of the abandonment of this application, but the test is whether applicant exercised due diligence in determining the problem and rectifying it.[9] "The negligence of an attorney does not discharge the duty of an applicant to exercise due diligence."[10] An applicant has a duty to ensure that his application is being prosecuted.[11] Therefore, applicant must establish with a documentary showing that he exercised diligence in attempting to further the prosecution of the above-identified application..

Fourth, the USPTO records indicate that power of attorney and the correspondence address of record remain with Mr. Hartman. There is no indication in the file that Mr. Crosby was ever empowered to prosecute the application. If Mr. Crosby or applicant desires to receive future correspondence regarding this application, the appropriate power of attorney documentation and a change of correspondence address must be submitted. Correspondence will continue to be sent to the address of record until the Office is notified otherwise. As a one-time courtesy, the Office will mail a copy of the present decision to Mr. Crosby at the address listed on the petition.

CONCLUSION

Applicant has not provided a sufficient showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

Accordingly, the petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." Extensions of time are permitted under 37 CFR 1.136(a).

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[7] Douglas v. Manbeck, 1991 U.S. Dist. LEXIS 16404, 21 USPQ2d 1687, 1700 (E.D. Pa. 1991), aff'd, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992).

[8] Id.

[9] Id.

[10] Id.; citing Smith V. Mossinghoff, 671 F.2d 533, 538 (D.C. Cir. 1981).

[11] Douglas v. Manbeck, 1991 U.S. Dist. LEXIS 16404, 21 USPQ2d 1687, 1700 (E.D. Pa. 1991), aff'd, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992); citing Winkler v. Ladd, 221 F. Supp. 550, 552 (D.D.C. 1962).

ALTERNATIVE VENUE

While the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable, petitioner is not precluded from seeking relief by filing a petition under

37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in 1.20(d)) required pursuant to 37 CFR 1.137(d).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

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